



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,636	06/03/2005	C. Suresh Kumar	94.04	4937
24033 7590 01/04/2010 KONRAD RAYNES & VICTOR, LLP 315 S. BEVERLY DRIVE # 210 BEVERLY HILLS, CA 90212				
EXAMINER DONLON, RYAN D				
ART UNIT 3695		PAPER NUMBER		
NOTIFICATION DATE 01/04/2010		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

krvuspto@ipmatters.com

### Office Action Summary

**Application No.**

10/537,636

**Applicant(s)**

KUMAR ET AL.

**Examiner**

RYAN D. DONLON

**Art Unit**

3695

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 10-20, 23, 42-45, 51-61, 64, 83 and 93-107 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 10-20, 23, 42-45, 51-61, 64, 83 and 93-107 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-646)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Requirement for Information***

1. In response to the 37 CFR 1.105 request in the 18 March 2009 Office Action, the Applicant has provided the portions of the disclosure which provide written description.

### ***Drawings***

2. The drawings were received on 18 August 2009. These drawings are acceptable.

### ***Response to Amendment***

3. The amendment to the specification made on 18 September 2009 has been entered.

### ***Status of Claims***

4. Claims 1-4, 10-20, 23, 42-45, 51-61, 64, 83, and 93-107 are pending and have been examined.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-4 10-20, 23, 42-45, 51-61, 64, and 83 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A claimed process is eligible for patent protection under 35 U.S.C. § 101 if:

"(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. See Benson, 409 U.S. at 70 ('Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines.');

Diehr, 450 U.S. at 192 (holding that use of mathematical formula in process 'transforming or reducing an article to a different state or thing' constitutes patent-eligible subject matter); see also Flook, 437 U.S. at 589 n.9 ('An argument can be made [that the Supreme] Court has only recognized a process as within the statutory definition when it either was tied to a particular apparatus or operated to change materials to a 'different state or thing' ');

Cochrane v. Deener, 94 U.S. 780, 788 (1876) ('A process is...an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.').<sup>7</sup> A claimed process involving a fundamental principle that uses a particular machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed. And a claimed process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to transform any other article, to transform the same article but in a manner not covered by the claim, or to do anything other than transform the specified article." (*In re Bilski*, 88 USPQ2d 1385, 1391 (Fed. Cir. 2008))

7. Also noted in *Bilski* is the statement, "Process claim that recites fundamental principle, and that otherwise fails 'machine-or-transformation' test for whether such claim is drawn to patentable subject matter under 35 U.S.C. §101, is not rendered patent eligible by mere field-of-use limitations; another corollary to machine-or-transformation test is that recitation of specific machine or particular transformation of specific article does not transform unpatentable principle into patentable process if recited machine or transformation constitutes mere 'insignificant post-solution activity.'" (*In re Bilski*, 88 USPQ2d 1385, 1385 (Fed. Cir. 2008)) Examples of insignificant post-

solution activity include data gathering and outputting. Furthermore, the machine or transformation must impose meaningful limits on the scope of the method claims in order to pass the machine-or-transformation test. Please refer to the USPTO's "Guidance for Examining Process Claims in view of *In re Bilski*" memorandum dated January 7, 2009, [http://www.uspto.gov/web/offices/pac/dapp/opla/documents/bilski\\_guidance\\_memo.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/documents/bilski_guidance_memo.pdf) .

8. It is also noted that the mere recitation of a machine in the preamble in a manner such that the machine fails to patentably limit the scope of the claim does not make the claim statutory under 35 U.S.C. § 101, as seen in the Board of Patent Appeals Informative Opinion *Ex parte Langemyr et al.* (Appeal 2008-1495), <http://www.uspto.gov/web/offices/dcom/bpai/its/fd081495.pdf> .

9. Claims 1-4 10-20, 23 recite a process comprising the steps of using, receiving and assessing, selecting, comparing, determining, and indicating. These steps are not tied to a particular machine or apparatus nor do they transform a particular article into a different state or thing, thereby failing the machine-or-transformation test; therefore, claims 1-4, 10-20 and 23 are non-statutory under § 101.

10. The Examiner notes the "using a computer including a processor step" does not specifically state which steps, if any, are being performed by a particular machine or being performed by a user of a computer. Therefore the broadest reasonable

interpretation of this claim includes a mere human implemented method. Another reasonable interpretation of this claim would be that the machine is a general purpose computer, as there are no limitations which state they are being performed by the machine rather than in response to the user performing the step.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-4, 10-20, 23, 42-45, 51-61, 64, 83, and 93-107 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hargrove Jr. et al., US 5897613 (hereinafter Hargrove) in view of Applicant's admission.

13. As per **claim 1** :

Hargrove discloses a computer-implemented method for evaluating risk associated with underwriting an insurance policy, comprising:

using a computer including a processor:

Storing high risk zones (reads on weather conditions that are recorded for an area) that identify, for each of multiple landmarks (fields), an associate peril and zones in proximity to the landmark, wherein each of the zones has associated loss factors (see lines 22-44 in column 3);

receiving one or more locations to be covered under the insurance policy for one or more perils (see at least column 8); and

automatically assessing risk associated with the one or more locations, including generating rating results for one or more perils, wherein the rating results indicate whether that peril may occur at each of the one or more locations (see at least column 6, lines 42-56 and column 5 lines 21-27)

14. **Hargrove does not disclose** assessing risk by:

selecting a high risk zone based on the one or more perils;

comparing the one or more locations with the selected high risk zone;

and in response to determining a probable maximum loss (PML) that indicates an amount of loss expected based on a total exposure underwritten for the selected high risk zone and the one or more perils times a loss factor;

determining whether the PML exceeds a PML limit;

in response to determining that the PML does not exceed the PML limit, issuing a first report indicating that the insurance policy is to be issued; and

in response to determining that the PML exceeds the PML limit, issuing a second report indicating that the insurance policy is not to be issued.

15. **However, Applicant discloses** that one of ordinary skill in the art at the time of the invention would recognize it was obvious that in response to determining a probable maximum loss (PML) that indicates an amount of loss expected based on a total exposure underwritten for the selected high risk zone and the one or more perils times loss factor (see at least paragraph [0005] of Applicant's specification);

determining whether the PML exceeds a PML limit;

in response to determining that the PML does not exceed the PML limit, issuing a first report indicating that the insurance policy is to be issued; and

in response to determining that the PML exceeds the PML limit, issuing a second report indicating that the insurance policy is not to be issued (see at least paragraphs [0004]-[0008]).

It would have been obvious to one of ordinary skill in the art to include in the practice of assessing risk Hargrove, the practice of assessing risk as taught by the Applicant because this would have managed the totally risk exposure of the insurance company. Further, the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

16. **Further Hargrove discloses** selecting a high risk zone based on the one or more perils; and comparing the one or more locations with the selected high risk zone (see at least column 14 lines 42-52);

It would have been obvious to one of ordinary skill in the art to include in the practice of assessing risk Hargrove in view of Applicant's admission, the practice of selecting a high risk zone as taught by Hargrove because this would have helped automate the well known practice as disclosed by the applicant. Further, because the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately, and one



of ordinary skill in the art would have recognized that the results of the combination were predictable.

Therefore, it would have been obvious to one of ordinary skill in the art to combine the teachings Hargrove and the old and the well known practice as disclosed by the applicant to obtain the invention as specified in claim 1

17. As per **claim 2**:

Hargrove discloses a method of claim 1, wherein automatically assessing further comprises:

applying at least one business rule (see at least column 7 lines 1-9).

18. As per **claim 3**:

Hargrove discloses a method of claim 1, further comprising:

providing selection of at least one of an underwriting analysis and a risk analysis (see at least column 6 line 42-56).

19. As per **claim 4**:

Hargrove discloses a method of claim 1, further comprising:

providing setup of an event (hail) that may impact assessment of risk (see at least column 5 lines 21-27).

20. As per **claim 10**:

Hargrove discloses a method of claim 1, wherein a location is selected by at least one of a company search, an address search (legal description), or uploading a file (see at least column 8 lines 35-49. For the purposes of applying prior art, the Examiner has interpreted this claim in the alternative as it has been presented. Any dependant claims relying on the unconsidered alternatives of this claim for antecedent bases will be rejected under the same rationale as this claim).

21. As per **claim 11**, the claim recites "The method of claim 10, wherein selection of a location by company search further comprises:

receiving at least part of a *company name*;

searching for the company name in a business data store;

and retrieving at least one address from the searching" (emphasis added). The antecedent basis for this claim is an alternative element of claim 10, specifically "a company search". This claim is therefore rejected under the same rationale as claim 10 above, since it is a further limitation of an unconsidered alternative element.

22. As per **claim 12**, this claim recites "The method of claim 11, further comprising: determining that there are ambiguous addresses for the *company name*; and providing selection of at least one of the addresses" (emphasis added). This claim depends from claim 11 above which further limited an alternative element of claim 10. This claim is therefore rejected under the same rationale as claim 10 above, since it is a further

limitation of an unconsidered alternative element.

23. As per **claim 13**:

Hargrove does not specifically disclose a method of claim 10, wherein selection of a location by an address search further comprises:

receiving a street address and at least one of a zip code and a city and state.

However Hargrove does disclose entering the "legal description" of the location. It would have been obvious (if not inherent) to one skilled in the art at the time of the invention to include a street address and at least one of a city, state or zip code in a legal description because this would have been a well known standard to identify a location for the postal service.

24. As per **claim 14**, the claim recites, "The method of claim 10, wherein selection of a location by uploading a file further comprises: associating data in the file with a predefined format." The antecedent basis for this claim is an unconsidered alternative element of claim 10, specifically "by uploading a file". This claim is therefore rejected under the same rationale as claim 10 above, since it is a further limitation of an unconsidered alternative element.

25. As per **claim 15**:

Hargrove discloses a method of claim 10, further comprising:

automatically geocoding the selected location (see at least column 8 lines 15-65,

wherein there is disclosed a field ID automatically assigned).

26. As per **claim 16**:

Hargrove discloses a method of claim 10, wherein the location can not be automatically geocoded and further comprising:

providing use of a spatial interface to manually geocode the location (see at least column 8 lines 15-65 wherein there is disclosed a manual selection of fields).

27. As per **claim 17**:

Hargrove discloses a method of claim 1, wherein automatically assessing risk further comprises:

performing a proximity analysis (see at least the points in column 7 lines 60-67 and column 8 lines 15-65).

28. As per **claim 18**:

Hargrove does not disclose a method of claim 1, wherein the rating results for at least one peril are displayed on a map.

29. However does discloses location ratings results for locations for peril (column 5 lines 22-27) and displaying data for a particular location in (see at least column 8 lines 15-34) and also a policy map (column 11 lines 11-21). Rates on a field by field basis are also disclosed (see at least column 4 lines 33-49). It would have been obvious for the system to be capable to display the ratings for the fields on the map because this would

have been a similar display to the well known predictive weather map for helping to identify the risk associate with a policy or crop risks.

30. As per **claim 19** :

Hargrove discloses a method of claim 1, further comprising:

providing drilldown into details of at least a portion of the rating results (see at least column 4 lines 33-50 and column 7 lines 9-21, wherein it is disclosed that rates may be displayed and determined on a field by field basis)

31. As per **claim 20**:

Hargrove discloses a method of claim 1, further comprising:

providing exporting (displayed on monitor) of the rating results (policies) (see at least column 7 lines 22-43).

32. As per **claim 23**, :

Hargrove discloses a method of claim 1, wherein assessing risk associated with the location further comprises:

assessing risk based on at least one of unbound policies and bound policies (see at least column 5 lines 43-61).

33. As per **claims 42 and 83**, these claims are rejected under the same rationale as claim 1 above.

34. As per **claims 43 and 93**, these claims are rejected under the same rationale as claim 2 above.

35. As per **claims 44 and 94**, these claims are rejected under the same rationale as claim 3 above

36. As per **claims 45 and 95**, these claims are rejected under the same rationale as claim 3 above

37. As per **claims 51 and 96**, these claims are rejected under the same rationale as claim 10 above.

38. As per **claims 52 and 97**, these claims are rejected under the same rationale as claim 11 above.

39. As per **claims 53 and 98**, these claims are rejected under the same rationale as claim 12 above.

40. As per **claims 54 and 99**, these claims are rejected under the same rationale as claim 13 above.

41. As per **claims 55 and 100**, these claims are rejected under the same rationale as claim 14 above.

42. As per **claims 56 and 101**, these claims are rejected under the same rationale as claim 15 above.

43. As per **claims 57 and 102**, these claims are rejected under the same rationale as claim 16 above.

44. As per **claims 58 and 103**, these claims are rejected under the same rationale as claim 17 above.

45. As per **claims 59 and 104**, these claims are rejected under the same rationale as claim 18 above.

46. As per **claims 60 and 105**, these claims are rejected under the same rationale as claim 19 above.

47. As per **claims 61 and 106**, these claims are rejected under the same rationale as claim 20 above.

48. As per **claims 64 and 107**, these claims are rejected under the same rationale as claim 23 above.

### ***Response to Arguments***

49. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

50. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN D. DONLON whose telephone number is (571)270-3602. The examiner can normally be reached on Monday through Friday 7:30am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on (571) 272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. D. D./  
Examiner, Art Unit 3695  
December 27, 2009

/Narayanswamy Subramanian/  
Primary Examiner, Art Unit 3695